

## **REMARKS**

### **CLAIM REJECTIONS UNDER 35 U.S.C. §112**

In the Office Action dated September 20, 2004, the Examiner rejected claim 6 under 35 U.S.C. §112, first paragraph. The Examiner stated:

"Claim 6 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for cutting the roll of material to provide a sheet of material after applying adhesive, does not reasonably provide enablement for cutting the roll of material to provide a sheet of material before applying the adhesive. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims."

The above stated rejection of the Examiner has been obviated by the present Amendment in that claim 6 has been cancelled. Thus, no further comments concerning the Examiner's rejection of claim 6, or his rationale in supporting such rejection, is believed necessary, in order to be fully responsive to the rejection.

In the Office Action dated September 20, 2004, the Examiner also rejected claims 7 - 9 under 35 U.S.C. 112, first paragraph. The Examiner stated,

"Claims 7-9 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for covering the outer surface and bottom of a flower pot, does not reasonably provide enablement for covering only a portion of the outer surface or bottom, as encompassed by "at least a portion of" an outer surface or bottom or leaving the bottom uncovered. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims."

The above stated rejection of the Examiner has been obviated in part by the present Amendment in that claims 8-9 have been cancelled and claim 7 has been amended to recite that the bottom and outer surface of the flower pot are covered by the sheet of material. Thus, no further comments concerning the Examiner's rejection of claims 7-9,

or his rationale in supporting such rejection, is believed necessary, in order to be fully responsive to the rejection.

In the Office Action dated September 20, 2004, the Examiner also rejected claims 11 - 30, under 35 U.S.C. 112, first paragraph. The Examiner stated,

“Claims 11-30 are rejected under U.S.C. 112, first paragraph, because the specification, while being enabling for the pot cover having bonding material disposed on at least a portion of its inner surface when placing the pot into the interior space thereof, does not reasonably provide enablement for bonding material disposed on the outer surface of the pot cover. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.”

The above stated rejection of the Examiner has been obviated by the present Amendment in that claims 11-30 have been cancelled. Thus, no further comments concerning the Examiner's rejection of claims 11-30, or his rationale in supporting such rejection, is believed necessary, in order to be fully responsive to the rejection.

In the Office Action dated September 20, 2004, the Examiner also rejected claim 18, under 35 U.S.C. 112, first paragraph. The Examiner stated,

“Claim 18 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.”

The above stated rejection of the Examiner has been obviated by the present Amendment in that claim 18 has been cancelled. Thus, no further comments concerning the Examiner's rejection of claim 18, or his rationale in supporting such rejection, is believed necessary, in order to be fully responsive to the rejection.

In the Office Action dated September 20, 2004, the Examiner also rejected claims 24 and 25, under 35 U.S.C. 112, first paragraph. The Examiner stated,

“Claim 24 and 25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.”

The above stated rejection of the Examiner has been obviated by the present Amendment in that claims 24 and 25 have been cancelled. Thus, no further comments concerning the Examiner’s rejection of claims 24 and 25, or his rationale in supporting such rejection, is believed necessary, in order to be fully responsive to the rejection.

In the Office Action dated September 20, 2004, the Examiner also rejected claim 29, under 35 U.S.C. 112, first paragraph. The Examiner stated,

“Claim 29 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for pot cover preformed to fit a pot having a specific size and shape, does not reasonably provide enablement for pot cover preformed to fit pots having different sizes and shapes, The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.”

The above stated rejection of the Examiner has been obviated by the present Amendment in that claim 29 has been cancelled. Thus, no further comments concerning the Examiner’s rejection of claim 29, or his rationale in supporting such rejection, is believed necessary, in order to be fully responsive to the rejection.

## **CLAIM REJECTIONS UNDER DOUBLE PATENTING REJECTION**

In the Office Action dated September 20, 2004, the Examiner rejected claims 1-5 and 10, under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of U.S. Patent No. 5,459,976. The Examiner stated,

“US 5,459,976 claims a method for wrapping a floral grouping comprising: providing a sheet of material having upper and lower surfaces; passing at least a portion of the sheet by an adhesive strip applicator comprising a housing and means for causing a portion of adhesive transfer tape to contact the sheet; placing the floral grouping on the sheet and wrapping the sheet about the floral grouping, the passing and wrapping in a continuous process.”

The before stated rejection of the Examiner of claims 1-5 and 10, under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of U.S. Patent No. 5,459,976 has been obviated by the filing herewith a Terminal Disclaimer wherein the term of any patent granted on the subject matter of claims 1-5 and 10 will not extend beyond the term of U.S. Patent No. 5,459,976.

Therefore, it is respectfully requested that the Examiner withdraw his rejection and pass such claims to issue.

In the Office Action dated September 20, 2004, the Examiner rejected claims 11, 14, 15, 17, 21, 23 and 26-28, under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 6, 8 and 9 of U.S. Patent No. 5,820,712. The Examiner stated,

“US 5,820,712 claims a method for covering a flower pot comprising: providing a preshaped pot cover having an upper end, outer surface, inner surface, interior space and base and having an adhesive or cohesive bonding material disposed upon at least one of the inner surface and inner bottom surface, pot cover preshaped to conform to a pot having specific size and shape; providing a pot; placing the pot into the interior space of the pot

cover; and bondingly connecting via the bonding material securing the pot cover about the pot; wherein the pot has bonding material upon a portion of its outer surface or the pot cover further comprises a skirt or the bonding material on the pot cover has a release strip which is removed.”

The Examiner’s rejection of claims 11, 14, 15, 17, 21, 23 and 26-28, under the judicially created doctrine of obviousness-type double patenting has been obviated by the present Amendment in that such claims have been cancelled. Thus, no further comments concerning the rejection of such claims, or the Examiner’s rationale in support of such rejection, is deemed necessary in order to be responsive to the Office Action dated September 20, 2004.

In the Office Action dated September 20, 2004, the Examiner rejected claim 30 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 5,820,712 in view of FR 2 610 604. The Examiner stated,

“U.S. Patent 5,820,712 does not claims that the pot cover is formed of a material selected from a group including polymer film.

FR 2 610 604 teaches that for covering a flower or plant container such as a pot, a film of porous and water-resistant plastic material is formed into a three-dimensional object corresponding to an outer shape of a container used for growing flowers or plants (Abstract).”

The Examiner’s rejection of claim 30, under the judicially created doctrine of obviousness-type double patenting, has been obviated by the present Amendment in that such claim has been cancelled. Thus, no further comments concerning the rejection of such claim, or the Examiner’s rationale in support of such rejection, is deemed necessary in order to be responsive to the Office Action dated September 20, 2004.

In the Office Action dated September 20, 2004, the Examiner rejected claims 11-17, 19, 21, 23, 27 and 28 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 6, 8 and 9 of U.S. Patent No. 6,533,886.

The Examiner stated,

“US 5,820,712 (sic) claims a method for covering a flower pot comprising: providing a preformed pot cover having an inner surface, bottom surface and opening and having an adhesive strip disposed upon at least a portion of the inner surface; providing a pot; placing the pot into the opening of the pot cover; and bondingly connecting via the bonding material securing the pot cover about the pot; wherein the pot has bonding material upon a portion of its outer surface or the pot cover further comprises a skirt extending from the upper end of the pot cover of the bonding material on the pot cover has a release strip which is removed.

By providing a preformed pot having a bottom surface and an opening into which the pot is placed, the pot cover has a base, an interior space, an outer peripheral surface and an outer bottom surface as claimed.”

The Examiner's rejection of claims 11-17, 19, 21, 23, 27 and 28, under the judicially created doctrine of obviousness-type double patenting has been obviated by the present Amendment in that such claims have been cancelled. Thus, no further comments concerning the rejection of such claims, or the Examiner's rationale in support of such rejection, is deemed necessary in order to be responsive to the Office Action dated September 20, 2004.

#### **CLAIM REJECTIONS UNDER 35 U.S.C. §103(a)**

In the Office Action dated September 20, 2004, the Examiner rejected claims 11-17, 19, 21, 24 and 26-30 under 35 U.S.C. 103(a) as being unpatentable over FR 2 610 604 in view of Crawford 3,962,503. The Examiner stated,

"FR 2 610 604 discloses a method of covering a flower or plant container such as a pot, planter or similar object comprising: forming a sheet of decorated and moisture resistant plastic material into a three-dimensional object corresponding to an outer shape of a container used for growing flowers or plants, the object having edges bent outward to form a continuous lip which extends beyond the top of the pot (skirt); and applying the formed object to the outside of the container (Abstract and oral translation). FR '604 does not disclose providing the formed object with a bonding material upon a portion of at least one of its inner and outer surfaces.

Crawford teaches that to provide a decorative, moisture retaining device for a floral container such as a pot which will adhere to the container thereby facilitating the handling of the containers without the protective device becoming disarranged, spaced pressure sensitive adhesive spots are provided to adhere the device to the lower face of the pot or container so as to maintain the pot in fixed relation with respect to the tray and sheet of material of the device. The adhesive is provided with treated paper covering to prevent sticking to undesired objects until it is desired to assemble with a pot (col. 1, lines 5-63, col. 3, lines 5-20)."

The Examiner's rejection of claims 11-17, 19, 21, 24, 26-28, under the judicially created doctrine of obviousness-type double patenting has been obviated by the present Amendment in that such claims have been cancelled. Thus, no further comments concerning the rejection of such claims, or the Examiner's rationale in support of such rejection, is deemed necessary in order to be responsive to the Office Action dated September 20, 2004.

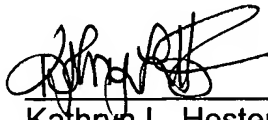
### **Conclusion**

The claims presently pending in the subject application are claims 1-5 and 10 which were rejected only under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of U.S. Patent No. 5,459,976. The remaining claims in the application have been cancelled by the present Amendment. Therefore, it is respectfully submitted that the case is now in condition for allowance and

it is requested that the Examiner withdraw the rejection of claims 1-5 and 10 (as amended) and pass such claims to issue in light of the Terminal Disclaimer filed herewith.

The foregoing is intended to be a complete response to the Office Action dated September 20, 2004. Should the Examiner have any questions regarding the contents of this response, or any other matter, the undersigned would welcome a telephonic interview with the Examiner to discuss such matters.

Respectfully submitted,



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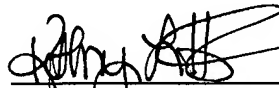
Agent for Applicant



the term as presently shortened by any terminal disclaimers of said **U.S. Patent No. 5,459,976** in the event that said **U.S. Patent No. 5,459,976** later: (1) expires for failure to pay a maintenance fee; (2) is held unenforceable or are found invalid by a court of competent jurisdiction; (3) is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. § 1.321; (4) has all claims canceled by a reexamination certificate; (5) is reissued; or (6) is otherwise not deemed to provide the rights conveyed by 35 U.S.C. §§ 154-156 and 173 prior to the expiration of the full statutory term(s) as presently shortened by any terminal disclaimer(s), except for the separation of legal title stated above.

3-17-05  
Date

By:



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☒ Terminal disclaimer fee under 37 CFR 1.20(d) is included.